

REMARKS

This paper responds to the Final Office Action dated April 11, 2006 in which all of the pending claims, Claims 1-23 and 28-31, were rejected. The Applicant has amended the claims to address the rejections and has placed the application in a condition for allowance.

The Examiner rejected Claims 19-22 under 35 U.S.C. 101 because the claimed invention is directed toward non-statutory subject matter: “the claims recite a “means for selling the personalized songs”, which in the opinion of the examiner as this is best understood, includes people. Human beings are not allowed to be claimed as part of an invention in article claims.”

The Applicant respectfully suggests that the Examiner has taken the tack of a straw man argument. No limitation in Claims 19-22 recites the presence of a human being except that a “request to an artist” is made and the composed song is received. The composition of the song, specifically, is not claimed. The Artist will compose the song. The claimed method presents the request for a song and receives the song once composed.

The Supreme Court has construed §101 broadly, noting that Congress intended statutory subject matter to “include anything under the sun that is made by man.” *See Diamond v. Chakrabarty*, 447 U.S. 303, 309, 65 L. Ed. 2d 144, 100 S. Ct. 2204 (1980) (quoting S. Rep. No. 82-1979, at 5 (1952); H.R. Rep. No. 82-1923, at 6 (1952)); *see also Diamond v. Diehr*, 450 U.S. 175, 182, 67 L. Ed. 2d 155, 101 S. Ct. 1048 (1981). Despite this seemingly limitless expanse, the Court has specifically identified three categories of unpatentable subject matter: “laws of nature, natural phenomena, and abstract ideas.” *See Diehr*, 450 U.S. at 185.

In this case, the method claims at issue fall within the “process” and “manufacture” categories of the four enumerated categories of patentable subject matter in §101. “Process” is defined in 35 U.S.C. §100(b) to encompass: “[a] process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.” In *American Fruit Growers, Inc. v. Brogdex Co.*, the Supreme Court defined the verb form of “manufacture”

as “the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery.” 283 U.S. 1, 11, 75 L. Ed. 801, 51 S. Ct. 328, 1931 Dec. Comm’r Pat. 711 (1931) (quoting the *Century Dictionary*). An “article” is “one of a class of material things . . . piece of goods: COMMODITY.” *Webster’s* at 123 (emphasis added). The system based upon a database as taught in Claim 19 (from which Claim 20 depends) fits well into the manufacture category as each of independent claims 1, 9, 15, and 23 fall into either of the process or manufacture categories.

As claimed, the system of Claim 19 facilitates the generation of distinct songs from those stored in the database and further facilitates sale of those songs. Such is a useful, concrete, and tangible result. As such, the system is statutory. Nowhere is there claimed the intervention of a human.

The Examiner is respectfully reminded of the Court’s admonition in *State Street*:

The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to--process, machine, manufacture, or composition of matter--but rather on the essential characteristics of the subject matter, in particular, its practical utility. Section 101 specifies that statutory subject matter must also satisfy the other “conditions and requirements” of Title 35, including novelty, nonobviousness, and adequacy of disclosure and notice. For purpose of our analysis, as noted above, claim 1 is directed to a machine programmed with the Hub and Spoke software and admittedly produces a “useful, concrete, and tangible result.” This renders it statutory subject matter, even if the useful result is expressed in numbers, such as price, profit, percentage, cost, or loss.

State St. Bank & Trust Co. v. Signature Fin. Group, 149 F.3d 1368, 1375 (Fed. Cir. 1998).

The Court went on to explain that business methods were not, *per se*, unpatentable. A method such as that set forth in the instant Claim 19 is not to be judged as non-statutory under §103 because it is a business method:

The district court announced the precepts of the business method exception as set forth in several treatises, but noted as its primary reason for finding the patent invalid under the business method exception as follows:

If Signature's invention were patentable, any financial institution desirous of implementing a multi-tiered funding complex modelled (sic) on a Hub and Spoke configuration would be required to seek Signature's permission before embarking on such a project. This is so because the '056 Patent is claimed [sic] sufficiently broadly to foreclose virtually any computer-implemented accounting method necessary to manage this type of financial structure.

Whether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§ 102, 103 and 112. Assuming the above statement to be correct, it has nothing to do with whether what is claimed is statutory subject matter.

In view of this background, it comes as no surprise that in the most recent edition of the Manual of Patent Examining Procedures (MPEP) (1996), a paragraph of §706.03(a) was deleted. In past editions it read:

Though seemingly within the category of process or method, a method of doing business can be rejected as not being within the statutory classes.

MPEP § 706.03(a) (1994). This acknowledgment is buttressed by the U.S. Patent and Trademark 1996 Examination Guidelines for Computer Related Inventions which now read:

Office personnel have had difficulty in properly treating claims directed to methods of doing business. Claims should not be categorized as methods of doing business. Instead such claims should be treated like any other process claims.

Examination Guidelines, 61 Fed. Reg. 7478, 7479 (1996). We agree that this is precisely the manner in which this type of claim should be treated. Whether the claims are directed to subject matter within § 101 should not turn on whether the claimed subject matter does "business" instead of something else.

State St. Bank & Trust Co. v. Signature Fin. Group, 149 F.3d 1368, 1376-1377 (Fed. Cir. 1998)

In the Final Office Action, the Examiner went on to cite the second paragraph of 35 U.S.C. 112 as grounds for rejection of Claims 8 and 19. For claim 8, the language "wherein generating a song" has no antecedent basis. Determining whether a claim is definite requires an

analysis of “whether one skilled in the art would understand the bounds of the claim when read in light of the specification If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.” *Miles Lab., Inc. v. Shandon, Inc.*, 997 F.2d 870, 875, 27 U.S.P.Q.2D (BNA) 1123, 1126 (Fed. Cir. 1993). As amended, recording the song is recording to a recording medium and as such is certainly definite.

As amended, Claim 19 is directed to the recording distribution center of the specification for “selling the personalized songs.” The recording distribution center is shown in FIG. 1 and is suitably discussed in passages in the instant application from Page 5, line 14 through to Page 6, line 31. The Examiner stated that the recording distribution center lacked structure. In the seminal computer hardware and software case in the Federal Circuit, *In re Alappat*, 33 F.3d 1526 (Fed. Cir. 1994) (en banc), the court adopted precisely the same sort of “configured to” language to describe the structure of electronic circuitry. The claims at issue in *In re Alappat* were drafted in means plus function form. The Federal Circuit constructed a hypothetical claim, based on the claim as drafted, including bracketed phrases, wherein “the subject matter in brackets represent[s] the structure which Alappat discloses in his specification as corresponding to the respective means language recited in the claims.” *Id.* at 1541. For example, the court rewrote claim element (a) as “[an arithmetic logic circuit configured to perform an absolute value function, or an equivalent thereof] for determining the vertical distance between the endpoints of each of the vectors in the data list.” *Id.* The use of “configured to” in the claims at issue here is not different in any material way from the use of the phrase “arithmetic logic circuit configured to” in *In re Alappat*. In both cases, the claims recite a device or set of devices and the way in which the device or devices are configured.

The Examiner went on to reject Claims 1, 3, 6-8, 9-14, 19-22, and 28-30 as anticipated under 35 U.S.C. 102(b) by “Song Legacy Custom Songs,” based upon a non-enabling advertisement found on the Internet. Nothing within the web-based advertisement indicates the process by which a song is generated. Because a putatively similar product is produced, i.e., a

customized song, the Examiner has employed “Official Notice” to find that all of the elements of instant application are present.

Official Notice was defined in the Court of Claims and Patent Appeals case, *In re Ahlert*, 424 F.2d 1088, 1091-1092 (C.C.P.A. 1970) where the Court recognized that the Patent Office “may take notice of facts beyond the record which, while not generally notorious, are capable of such instant and unquestionable demonstration as to defy dispute.” Such a power is narrowly construed by the courts and the federal courts are charged to

“regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.”

Further, “[a]llegations concerning specific ‘knowledge’ of the prior art which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.”

For claims 19, 21, and 22, the Examiner asserts that “Song legacy discloses a system as claimed. Song legacy discloses that requests can be sent by email or by phone.” However, the Examiner then disqualifies Song Legacy as prior art by presuming that the “means for generating a request to an artist is considered to be the employees of Song Legacy: somebody has to inform the artist what to produce.” The instant application is inherently tied to the use of a database. Rather than addressing the role of the request acquisition center, the fact that the employees of Song Legacy can produce a similar result does not allow the conclusion that the employees in performing their actions anticipate the instant claim.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 Fed. Cir. 1987). The MPEP states at § 2131.02: “The identical invention must be shown in as complete detail as is

contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

The Examiner has reasoned that because the method of Claim 19 of the instant application will produce a result similar to that of Song Legacy that the instant application teaches the identical elements as those existing within Song Legacy. This is impermissible reasoning. Every element of the claimed invention must be literally present, arranged as in the claim. *Perkin-Elmer Corp.*, 732 F.2d at 894, 221 USPQ at 673; *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771-72, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026, 79 L. Ed. 2d 687, 104 S. Ct. 1284 (1984). The identical invention must be shown in as complete detail as is contained in the patent claim. *Jamesbury Corp.*, 756 F.2d at 1560, 225 USPQ at 256; *Connell*, 722 F.2d at 1548, 220 USPQ at 198. The details have not been shown to be present here. To make such assertions of fact a matter of record, the law requires an affidavit of the Examiner. When a rejection is based on facts within the personal knowledge of the Examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the Examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. See 37 CFR 1.104(d)(2). Here, the factual grounds for rejection are inadequate.

Use of a database is taught and claimed throughout the patent (e.g. 3:26, 3:29, 4:28, 5:25, and 6:3). Though Claims 1, 9, 15, 19, and 23 are independent claims directed toward use of a database, the Examiner, instead, recognizes that Song Legacy “discloses that songs are stored on a disk. To store songs on disk you must have a means to store the song, such as hardware and software that allow the storage operation to occur. The database can be interpreted to be the CDs with stored songs.” However, “database” is defined in the Microsoft Computer Dictionary (Fifth Edition) at page 141 as “[a] file composed of records, each containing fields, *together with a set of operations for searching, sorting, recombining and other functions.*” (emphasis added.) CDs

with stored songs are not a database as they have no set of operations for searching, sorting, or recombining data. Thus, the use of Song Legacy as prior art is inapt.

Similarly, the Examiner asserts that the “means for selling the songs can be the employees themselves or their website that advertises the business. The means for receiving the song is taken to be the manner in which the song is distributed to the requestor.” Again, this is a citation to Song Legacy for the purpose of proving merely that because a similar result can be achieved, Song Legacy cannot be presumed to produce that similar result because of an identity of method. This identity must be proven by facts generally known or supported by an Examiner affidavit.

Consider, for example, the Examiner’s reasoning when stating, “[f]or claim 20, the employees of Song Legacy are fully capable of making songs with the claimed genre. In the system claims recitations directed to the song itself receive minimal patentable weight because the songs are not part of the system.” The songs are part of the system and claimed as residing in a database as taught in Claim 19 (from which Claim 20 depends) as well as in each of independent claims 1, 9, 15, and 23, and the claims that depend from them. None of the claims are anticipated by Song Legacy.

The Examiner also rejected Claims 15-22 under 35 U.S.C. 102(b) as being anticipated by Clynes (United States Patent 5,590,282). The rejection is actually the two distinct rejections of Claims 15 and 19, the two independent claims in the group. These rejections are best dealt with separately as Claims 15 and 19 are not identical.

Clynes discloses a method of modifying stored songs. Clynes teaches a distribution system that is inherently limited to transfer of songs from the internet or “music information highway” as Clynes terms it. The Examiner has stated that “stored songs are made available for purchase as claimed because column 5, lines 7-9 disclose a fee that the user must pay to use the system.” That citation points to the inherent differences in the teachings of Clynes and Claim 15. Inherently, Claim 15 teaches the sale of media including at least one of a compact disc, a mini-

compact disc, an audiocassette, a record, an mp3 file, and a digital or analog recording device.

Clynes teaches away from media. As stated in Clynes, at the Summary of Invention section:

“music resulting from the combination of a music score and a microscore may be reproduced either at the central computer in digital or analog form and then transmitted to the subscriber, or may be reproduced at the subscriber’s post. The subscriber chooses the music score to be reproduced and also selects, modifies or creates the microscore to be imparted to the respective notes of the music score so as to render the performance of the composition meaningful and expressive in a way dictated by the subscriber.”

Column 4, lines 13-22. Clearly, the limitation inherently involves downloading to the TV terminal Clynes teaches (See FIG. 1).

The Examiner also rejected Claims 2, 4, 5, 23, and 31 as unpatentable under 35 U.S.C. 103(a) over “Song Legacy Custom Songs.” Song Legacy does not render the instant application obvious.

With the involved facts determined, the Examiner confronts a ghost, i.e., “a person having ordinary skill in the art,” not unlike the “reasonable man” and other ghosts in the law. To reach a proper conclusion under § 103, the Examiner must step backward in time and into the shoes worn by that “person” when the invention was unknown and just before it was made. In light of all the evidence, the Examiner must then determine whether the claimed invention as a whole would have been obvious at that time to that person. 35 U.S.C. § 103. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987)

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C.S. § 103(a) is casting the mind back to the time of invention in order to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-prevalent wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher. *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000).

The following comprises a selection of legal standards for determining scope and content of the prior art: first, that a prior patent must be considered in its entirety, i.e., as a whole, including portions that would lead away from the invention in suit, *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 U.S.P.Q. (BNA) 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851, 83 L. Ed. 2d 107, 105 S. Ct. 172 (1984); second, that elements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents, *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. (BNA) 929, 933 (Fed. Cir. 1984); and lastly, that an Examiner should avoid hindsight, *W.L. Gore & Associates, Inc.*, 721 F.2d at 1553, 220 USPQ at 313.

A determination that an invention would have been obvious when it was made to one of ordinary skill in the art under §103 must always be based upon the facts available at the time of the filing of the application. The “degree to which” it is one of fact is solely that degree required to erect a foundation of facts capable of supporting the conclusion, those facts having been found by applying correct legal standards and expressed in findings free from error and based on clear and convincing evidence. A determination that an invention would not have been obvious when it was made to one of ordinary skill in the art is also a conclusion of law.

Claims 1-18, 23, and 28-31, are rejected under 35 U.S.C. 103(a) as being unpatentable over “Song Legacy Custom Songs” in view of Clynes (United States Patent 5,590,282). Specifically, the Examiner rejects the claims based upon similar results, to wit: “For claims 1, 3-18, 23, Song Legacy discloses a company that makes customized songs for a requestor.” As set forth above, it is not enough to argue that a similar result occurs. The process or structure must be present. Reasserting all of the reasons set forth above, Song Legacy does not include all of the limitations of the subject claims.

While the Examiner provides no affidavit supplying his personal knowledge of Song Legacy, the Examiner states that “[f]or claims 9-14, 28-30, in addition to that above, Song Legacy inherently has a request acquisition center (the telephone and area where the phone is

located for the taking of song requests via the telephone), a recording development center (the recording studio), a reproduction center (the digital computer recording technology), an assignment center, and a distribution center (an area where finished recordings are located and ready to be delivered). Song Legacy, in view of Clynes, performs all of the functions of receiving a song request, modifying an original song, recording the modified song on a storage medium, and distributing the song, so all of the structural “centers” claimed are found in Song Legacy.”

Further, however, the admitted limitation missing from Song Legacy “that a song is retrieved and modified by altering the retrieved song to product the personalized song” is not supplied by Clynes. Over and above the deficiencies of Song Legacy, Clynes does not supply a song recorded on a medium, as discussed above. The combination of references does not cure the deficiencies of either reference.

The Examiner has reminded the Applicant that the application currently names joint inventors. The Applicant specifically avers that the subject matter of the various claims was commonly owned at the time any inventions covered herein were made. Mindful of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a), the Applicant again avers that all of the subject matter of the various claims was commonly owned at the time any inventions claimed herein were conceived.

CONCLUSION

The Applicants thank the Examiner for a thoughtful and thorough examination of the claims. The Applicants are grateful for the Examiner's insights. In the event that any of the claims as amended or the arguments set forth herein raise any questions, the Applicants request that the Examiner contact the Applicant's attorney of record, the undersigned.

Respectfully submitted,

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